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| 10/777,798 | 02/12/2004 | Mildred Karkoff | 1913A1 | 5845 |
| 7590 PPG Industries, Inc. Law-Intellectual Property One PPG Place Pittsburgh, PA 15272 | | | EXAMINER DUNHAM, JASON B | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/777,798

Applicant(s)

KARKOFF ET AL.

Examiner

JASON B. DUNHAM

Art Unit

3625

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11-18, 20-24, 27, 29-31, 34, 35, 37-39, 42, 43 and 45-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-18, 20-24, 27, 29-31, 34, 35, 37-39, 42, 43 and 45-49 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. In view of the appeal brief filed on November 21, 2008, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection under 35 USC 101 is set forth below. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid. A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

Claims 1-8, 11-18, 20-24, 27, 29-31, 34-35, 37-39, 42-43, and 45-49 are pending.

Claim Objections

Claim 22 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It would not be possible to infringe on independent claim 21 without infringing on dependent claim 22.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8, 11-18, 20-24, 27, 29-31, 34-35, 37-39, 42-43, and 45-49 are rejected under 35 USC 101.

Referring to claims 1-8, 11-18, and 20. Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute “descriptive material.” Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or

logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. The claims are merely directed towards non-statutory software per se; see applicant's specification paragraph 39

Referring to claims 21-24 and 27. The claims are directed towards non-statutory subject matter as they do not fall under one of the four categories of invention. See MPEP 2106: 35 U.S.C. 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter. The latter three categories define "things" or "products" while the first category defines "actions" (i.e., inventions that consist of a series of steps or acts to be performed). See 35 U.S.C. 100(b) ("The term process' means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material."). Furthermore, the claims are directed towards "Nonfunctional descriptive material", per se, such as music, literary works and a compilation or mere arrangement of data.

Referring to claims 29-31, 34-35, 37-39, 42-43, and 45-49. The claims are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, the claims are non-statutory since they may be performed within the human mind. Furthermore, insignificant extra solution activity (such as receiving, retrieving, outputting, or reviewing data as recited independent claims 29 and 38) will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyeret al-

[http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=](http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0)

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,6-8,12-18, 20-24, 29-31, 35, 37-39, 43, and 45-49 are rejected under 35 U.S.C. 103(a) as unpatentable over Tambay (US 2001/0037255) in view of Durham (US 5,974,388).

Referring to claim 1. Tambay discloses a computer-based system for illustrating product data comprising:

an input interface wherein a user selects one or more products (Tambay: figures 1-2);

at least one database comprising product data of the products (Tambay: paragraph 26);

a program in communication with the input interface and the at least one database, wherein the program retrieves selected product data for products selected by the user (Tambay: figure 3);

an output interface in communication with the program, which outputs and illustrates at least some of the selected product data retrieved from the database (Tambay: figures 2 and 4),

Tambay discloses all of the above but does not expressly disclose adjusting product data to generate additional product data.

Durham discloses a computer based system for illustrating product data:

wherein the computer-based system is interactive with the user, such that the user may adjust at least some of the product data retrieved from the database and illustrated in the output interface to generate additional product data (Durham: abstract and figure 14),

wherein the adjustable product data comprises one or more of a component mixing ratio, a RTS price and coating component data comprising one or more of a code, a description, a price, and a package size (Durham: figure 14 and column 8, line 61 – column 9, line 11).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the system of Tambay to have included adjusting product data including component mixing ratios comprising descriptions, in order to adjust paints according to customer wishes (Durham: figure 14).

Referring to claim 2. The combination of Tambay and Durham further discloses a system wherein the program communicates with the input interface, the database, and the output interface via a communication media comprising one or more types of computer networks (Tambay: figures 1).

Referring to claim 3. The combination of Tambay and Durham further discloses a system comprising a maintenance interface in communication with the database (Tambay: paragraph 24).

Referring to claim 4. The combination of Tambay and Durham further discloses a system comprising an output device in communication with the output interface (Tambay: figure 1 and paragraph 97).

Referring to claim 6. The combination of Tambay and Durham further discloses a system wherein the user selects at least two products (Tambay: paragraph 119 and 128 disclosing a user selecting a subset of products).

Referring to claim 7. The combination of Tambay and Durham further discloses a system wherein the input interface comprises a plurality of input screens (Tambay: paragraph 128).

Referring to claim 8. The combination of Tambay and Durham further discloses a system wherein the products comprise coatings (Tambay: abstract).

Referring to claim 12. The combination of Tambay and Durham further discloses a system wherein the input interface comprises a product search tool (Tambay: figure 3).

Referring to claim 13. The combination of Tambay and Durham further discloses a system wherein the search tool comprises a list of product suppliers and brands (Tambay: figure 4 and paragraphs 26 and 128).

Referring to claim 14. The combination of Tambay and Durham further discloses a system wherein the search tool comprises a list of paint lines (Tambay: paragraph 103).

Referring to claim 15. The combination of Tambay and Durham further discloses a system wherein the search tool comprises a list of product mix categories (Tambay: paragraph 119).

Referring to claim 16. The combination of Tambay and Durham further discloses a system wherein the search tool comprises a list of products (Tambay: figures 2-3).

Referring to claim 17. The combination of Tambay and Durham further discloses a system wherein the program resides on a server (Tambay: figure 1).

Referring to claim 18. The combination of Tambay and Durham further discloses a system wherein the database comprises product data for a plurality of products of a plurality of product suppliers (Tambay: figure 4 and paragraphs 26 and 128).

Referring to claim 20. The combination of Tambay and Durham further discloses a system wherein the system is capable of generating a report that illustrates the contents of the output interface (Tambay: paragraphs 58-65).

Referring to claim 21. Claim 21 is rejected under the same rationale set forth in the rejection of claim 1.

Referring to claim 22. The combination of Tambay and Durham further discloses a document comprising the report of claim 21 (Tambay: paragraph 115).

Referring to claims 23-24. Claims 23-24 are rejected under the same rationale set forth above in the rejection of claims 6, 8-10, and 19.

Referring to claims 29-31, 35, and 37. Claims 29-31, 35, and 37 are rejected under the same rationale set forth above in the rejection of claims 1,6-10,19,and 21-22.

Referring to claims 38-39, 43, and 45. Claims 38-39, 43, and 45 are rejected under the same rationale set forth above in the rejection of claims 1,7,9-10, and 21-22.

Referring to claims 46-49. The combination of Tambay and Durham further discloses systems and methods for illustrating competitive products (Tambay: figure 4 and paragraph 128 disclosing a user selecting product data from a multitude of suppliers).

Claims 5, 11, 27, 34, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Tambay and Durham in view of Howes (US 6,959,284).

Referring to claim 5. The combination of Tambay and Durham discloses all of the above but does not expressly disclose an output device consisting of a printer. Howes discloses a computer-based system for illustrating product data comprising an output device consisting of a printer (Howes: abstract and figure 5). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have

modified the system of Tambay/Durham to have included a printer, as taught by Howes, in order to better identify selected products (Howes: abstract and figure 5).

Referring to claim 11. The combination of Tambay and Durham discloses all of the above but does not expressly disclose a system wherein the description designates a quality grade of the coating. Howes discloses a computer-based system for illustrating product data wherein the description designates a quality grade of the coating (Howes: abstract and paragraph 19). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the system of Tambay/Durham to have included a quality grade of the coating, as taught by Howes, in order to assure customers of the quality of the coating (Howes: abstract).

Referring to claims 27, 34, and 42. Claims 27, 34, and 42 are rejected under the same rationale set forth above.

Response to Arguments

Applicant's arguments filed November 21, 2008 have been fully considered but they are not persuasive.

Applicant argues that the combination of Tambay and Durham does not disclose adjustable data fields as no consideration is given in Durham to adjusting the fields shown in figure 14. The examiner disagrees; as cited in the rejection of claim 1, Durham disclosed a customer choosing the type of substrate to be used and adjusting the product data accordingly as accomplished by the drop down menus (88 b, c, and d).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Durham and Tambay are both references related to the art of providing paint-related product information and a proper motivation has been cited in the rejection of claim 1.

Applicant further argues that the combination of Tambay and Durham does not disclose a user selecting two product as recited in claim 6. The examiner disagrees as at least paragraph 128 of Tambay discloses a user selecting a subset of products. This rationale holds for similarly rejected claims 23 and 30.

Applicant presents further arguments regarding the rejection of independent claims 21, 29, and 38 containing similar limitations to independent claim 1. These claims as well as their dependent claims are rejected under the same rationale presented above. Furthermore, the examiner notes that applicant has argued against a rationale for adjusting product data. This is an invalid argument as the combination of Tambay and Durham discloses adjustable product data as cited above, the rationale provided by the examiner is directed towards a motivation (as contained within Durham) for combining the two references. Lastly, the examiner notes there is no recitation of

product data comparison in the claims as argued by applicant on pages 11-12 of the brief.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/
Supervisory Patent Examiner, Art
Unit 3625